

#14
mjs
3-16-04
RECEIVED
CENTRAL FAX CENTER

PATENT 0 8 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

Inventor(s):	Zhimin He et al.		
Serial No.:	09/894,480	Examiner:	A. Castro
Filed:	June 27, 2001	Group Art Unit:	2653
Title:	Flexural Pivot for Rotary Disc Drive Actuator		
Docket:	STL9799		

REPLY BRIEF (37 C.F.R. § 1.193(b)(1))

This Reply Brief is filed in response to the Examiner's Answer mailed January 15, 2004 (hereinafter "Answer").

This Brief is being filed within the time limits prescribed by 37 CFR § 1.193, and is being filed in triplicate.

The Answer raised several new issues as follows:

- (1) Whether the limitation "transverse" is broad enough to describe the relationship between two elements which are merely "not parallel";
- (2) Whether U.S. Patent 6,205,005 to Heath (hereinafter "Heath") inherently discloses coincident pivot axis and actuator center of mass at col. 6, lines 38-50; and
- (3) Whether the Office, having at long last looked to the specification to interpret the means-plus-function language of claim 15, i.e., "means for pivotably coupling the actuator to the base," has properly construed this clause in continuing to reject that claim.

Argument

New Issue (1):

As set forth in the Appeal Brief filed November 4, 2003 (hereinafter "Appeal Brief"), independent claims 1 and 8 recite, among other limitations, "at least two leaves . . . transversely disposed at an angle to one another." The Appeal Brief further stated that Heath's elements 7,21 do not cross one another and therefore cannot reasonably be considered to be transverse to one another. In the Answer, the Office for the first time during the prosecution of this application has asserted that the term "transverse" requires nothing more than that two elements not be parallel to one another. This position is offered without support, and for good reason - there is no support for this position in the present specification, the prior art, nor from any other source. If the Office persists upon maintaining the ground of rejection based upon this questionable definition of the limitation "transverse," some support for clinging to this definition. Otherwise, reversal of the rejection of claims 1 and 8 is respectfully requested.

New Issue (2):

On page 7 of the Answer, the Office points to col. 6, lines 38-50 of Heath for support for the contention that Heath inherently discloses an arrangement in which "the pivot has a center of rotation generally coincident with a center of mass of the actuator" as required by claims 5 and 12. However, this portion of Heath merely refers to the fact that it is preferable that the disclosed springs not exert biasing forces which would hinder performance of the servo controller in moving the actuator arm. Again, Appellant recognizes that the claimed arrangement is desirable; however, the fact remains that it is not disclosed, explicitly or inherently, by Heath. Reversal of the rejection of claims 5 and 12 is respectfully requested.

New Issue (3):

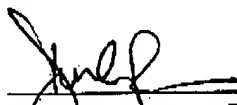
In the Appeal Brief, Appellant pointed out for the third time during prosecution of this application that the Office has a duty to look to the specification in determining the scope of the limitation, "means for pivotably coupling the actuator to the base" in claim 15. It is gratifying that the Office has finally deigned to acknowledge the existence of this duty. On pages 7-8 of the Answer, the Office cites to Part III of the *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. § 112, Par. 6*. The third element of this inquiry asks whether the prior art element is in fact an equivalent of the means-plus-function limitation in the claim. The Office dismisses the third element of the inquiry by asserting that Heath's arrangement performs its function in substantially the same way as the presently disclosed device because Heath is "providing leaves that are transversely disposed." However, as set forth in each response filed to date, and again above in response to *New Issue 1*, Heath leaves are not transverse to one another. Reversal of the rejection of claim 15 is respectfully requested.

Appellant maintains that present claims identify the features and benefits of the present invention clearly and concisely. The present invention as claimed is not taught or suggested by the prior art of record or any combination thereof. Therefore, it is respectfully submitted that the appealed claims are in condition for allowance, and reversal of all standing rejections is respectfully requested.

Respectfully submitted,

Seagate Technology LLC
(Assignee of the Entire Interest)

March 8, 2004
Date



Derek J. Berger, Reg. No. 45,401
Seagate Technology LLC
Intellectual Property Dept. - COL2LGL
389 Disc Drive
Longmont, CO 80503
(720) 684-2265 (telephone)
(720) 684-2588 (facsimile)

PTO/SB/21 (02-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/894,480	RECEIVED CENTRAL FAX CENTER MAR 08 2004	
	Filing Date	June 27, 2001		
	First Named Inventor	Zhimin He		
	Art Unit	2653		
	Examiner Name	A. Castro		
Total Number of Pages in This Submission	15	Attorney Docket Number	STL9799	OFFICIAL

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	Remarks	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Derek J. Berger, Reg. No. 45,401
Signature	<i>[Signature]</i>
Date	March 8, 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. Washington, DC 20231 on this date:

Typed or printed name	Zeina Smith		
Signature	<i>[Signature]</i>	Date	03/08/2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL
for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$)** 330.00**Complete If Known**

Application Number	09/894,480
Filing Date	June 27, 2001
First Named Inventor	Zhirmin He
Examiner Name	A. Castro
Art Unit	2653
Attorney Docket No.	STL9799

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit
Account
Number
Deposit
Account
Name

19-1038

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments☐ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1) (\$)			

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity, Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	1052 50	2052 25	Surcharge - late filing fee or oath	
1053 130	2053 130	1812 2,520	2,520	Surcharge - late provisional filing fee or cover sheet	
1812 2,520	1812 2,520	1804 920*	920*	Non-English specification	
1804 920*	1804 920*	1805 1,840*	1,840*	For filing a request for ex parte reexamination	
1805 1,840*	1805 1,840*	1251 110	2251 55	Requesting publication of SIR prior to Examiner action	
1251 110	2251 55	1252 420	2252 210	Requesting publication of SIR after Examiner action	
1252 420	2252 210	1253 950	2253 475	Extension for reply within first month	
1253 950	2253 475	1254 1,480	2254 740	Extension for reply within second month	
1254 1,480	2254 740	1255 2,010	2255 1,005	Extension for reply within third month	
1255 2,010	2255 1,005	1401 330	2401 165	Extension for reply within fourth month	
1401 330	2401 165	1402 330	2402 165	Extension for reply within fifth month	
1402 330	2402 165	1403 290	2403 145	Notice of Appeal	
1403 290	2403 145	1451 1,510	1451 1,510	Filing brief in support of an appeal	
1451 1,510	1451 1,510	1452 110	2452 55	Request for oral hearing	
1452 110	2452 55	1453 1,330	2453 665	Petition to institute a public use proceeding	
1453 1,330	2453 665	1501 1,330	2501 665	Petition to revive - unavoidable	
1501 1,330	2501 665	1502 480	2502 240	Petition to revive - unintentional	
1502 480	2502 240	1503 640	2503 320	Utility issue fee (or reissue)	
1503 640	2503 320	1460 130	1460 130	Design issue fee	
1460 130	1460 130	1807 50	1807 50	Plant issue fee	
1807 50	1807 50	1806 180	1806 180	Petitions to the Commissioner	
1806 180	1806 180	8021 40	8021 40	Processing fee under 37 CFR 1.17(c)	
8021 40	8021 40	1809 770	2809 385	Submission of Information Disclosure Stmt	
1809 770	2809 385	1810 770	2810 385	Recording each patent assignment per property (times number of properties)	
1810 770	2810 385	1801 770	2801 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1801 770	2801 385	1802 900	1802 900	For each additional invention to be examined (37 CFR 1.129(b))	
1802 900	1802 900			Request for Continued Examination (RCE)	
				Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

330.00

SUBMITTED BY

Name (Print/Type)

Derek J Berger

Signature

Registration No.
(Attorney/Agent)

45,401

(Complete if applicable)

Telephone 720-684-2265

Date

March 8, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.